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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,159	08/23/2001	Paul Clinton Coffin	10012828-1	1251

7590 08/11/2004  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

TRAN, HANH VAN

ART UNIT PAPER NUMBER

3637

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/938,159

Applicant(s)

COFFIN ET AL.

Examiner

Hanh V. Tran

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21, 22, 24-29 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 24-29 and 35-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/26/2004 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 21-22, 24-29, and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,116,063 to Foslien in view of USP 6,480,391 to Monson et al.

Foslien discloses a data storage system comprising all the elements recited in the above listed claims including, such as shown in Figs 2-3, a data storage system housing 30 having an

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opening, a first elongate bottom reference rail located adjacent the opening, a media storage device having a housing 54 movable between a storage position within the data storage system and an extended position, the housing having a top, a bottom and opposing ends, a first elongate bottom alignment groove adapted to slidably engage with the first elongate bottom reference rail of the data storage system housing 30, a locking plate attached to the housing and configured to engage a locking mechanism located in the opening in the data storage system, a handle operationally attached to the housing, a side portion of the housing having a plurality of slots (56,58) configured to receive the data media, a spring mechanism of a metallic strip configured to engage the data media when received within the slots, a plurality of dividers positioned in spaced-apart relation within the housing, wherein the media storage device may be inserted into and removed from the data storage system housing by slidably engaging the elongate bottom reference rail and the elongate bottom alignment groove and guiding the media storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing, the opposing ends of the media storage device housing being located along the longitudinal axis, the data media being inserted into and removed from the media storage device housing along an axis 64, such as shown in Fig 2, transverse to the longitudinal axis. Foslien further discloses it is well known that a data storage system (column 5, lines 3-30) including a picker assembly/a media handling system for transferring data media 60,62 from the media storage device to a data exchange device. Foslien, however, does not clearly disclose the data storage system housing having a second elongate top alignment groove in a top portion of the data storage system housing and the media storage device housing having a second elongate top alignment groove in a top portion of the media storage device housing adapted to slidably

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engage with the corresponding second elongate top reference rail located adjacent an opening in the data storage system.

Monson et al discloses a media storage device comprising a first housing 95 having means for slidably inserting and removing the media storage device within the opening in the data storage system housing 50, wherein said slidably inserting and removing means including a first elongate alignment groove in a top portion of the housing and a second elongate alignment groove in a bottom portion of the housing adapted to slidably engage with a corresponding first elongate reference rail located in a top portion of the data storage system housing 50 and a second elongate reference rail locate in a bottom portion of the data storage system housing 50 and adjacent an opening in the data storage system in order to facilitate inserting and removing the first housing from the data storage system. Therefore, it would have been obvious to modify the structure of Foslien by providing the housing with means for slidably inserting and removing the media storage device within the opening in the data storage system, wherein said slidably inserting and removing means including a first elongate alignment groove in a top portion of the housing and a second elongate alignment groove in a bottom portion of the housing adapted to slidably engage with a corresponding first elongate reference rail located in a top portion of the data storage system housing 50 and a second elongate reference rail locate in a bottom portion of the data storage system housing 50 and adjacent an opening in the data storage system in order to facilitate inserting and removing the housing from the data storage system, as taught by Monson et al, since both teach alternate conventional media storage device structure, used for the same intended purpose, thereby providing structure as claimed.

***Response to Arguments***

5. Applicant's arguments filed 7/26/2004 have been fully considered but they are not persuasive. In response to applicant's arguments on page 8 of the amendment that "neither *Foslien* nor *Monson* teaches or reasonably suggests at least the features/limitations emphasized above in claim 21", and arguments on page 9 regarding claim 36, the examiner takes the position that, as stated in the above art rejection, *Foslien*, as modified by *Monson*, discloses all the elements recited in said claim. More specifically, *Foslien*, as modified by *Monson*, teaches the idea of providing top and bottom elongate alignment grooves adapted to slidably engage with a respective one of first and second elongate reference rails, and guiding the media storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing, the opposing ends of the media storage device housing being located along the longitudinal axis, the data media being inserted into and removed from the media storage device housing along an axis 64, such as shown in Fig 2, transverse to the longitudinal axis.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (703) 308-6302. The examiner can normally be reached on Monday-Thursday, and alternate Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVT

August 08, 2004

A handwritten signature in black ink, appearing to read 'Hanh V. Tran', with a long horizontal flourish extending to the right.

**Hanh V. Tran**

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